

REMARKS

This application is a continued prosecution application. Claims 1-17 are pending in this application. The foregoing amendments have been made to address issues raised during the prosecution of the parent application. More particularly, the previous Final Office Action dated October 7, 1999 and the previous Advisory Action dated March 23, 2000 have been carefully reviewed, and it is believed that the foregoing amendments place this application in condition for allowance as discussed below.

OBJECTION TO THE SPECIFICATION AS FAILING TO PROVIDE ANTECEDENT BASIS

In the previous Final Office Action, the Examiner objected to the specification as failing to provide antecedent basis for the claimed subject matter. In particular, at page 2, paragraph 3 of the previous Final Office Action the Examiner stated the following:

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the limitation that the "thickness is less than 10.0 mils" is not supported by the specification . . . Said objection may be overcome by amending the specification to include said limitation.

After Applicant sought amendment to the parent specification to include the limitation that "[t]he non-woven layer of the present invention preferably has a thickness in the range of 1 to 2 mils, and the overall thickness of the present invention is preferably less than 10.0 mils", the Examiner stated in the previous Advisory Action that the proposed amendments would not be entered because they raise issues of new matter. In a teleconference with Applicant's attorney on March 31, 2000, the Examiner explained that the rationale for the new matter objection was that the limitation of "less than 10.0 mils" was not modified by the

term "preferably" in the claims as originally filed, and thus, the specification could not be amended to include "preferably less than 10.0 mils."

So, Applicant has herein amended the specification in this application to include the limitation that "[t]he non-woven layer of the present invention has a thickness of less than 10.0 mils." See page 10, lines 10 et seq. This amendment includes "less than 10.0 mils", but does not include "preferably less than 10.0 mils." Thus, Applicant respectfully submits that the specification as amended herein provides proper antecedent basis for the claimed subject matter without adding new matter.

REJECTION OF CLAIMS 1-17 UNDER 35 U.S.C. § 112 FIRST PARAGRAPH

In the previous Final Office Action, the Examiner rejected claims 1-17 under 35 U.S.C. § 112 for failing to reasonably provide enablement for "a plastic material" as recited in claims 1 and 10. In particular, at page 3 of the previous Final Office Action the Examiner stated the following:

Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling "a liquid impervious and/or solvent resistant plastic material" (page 6, lines 8-10), does not reasonably provide enablement for "a plastic material" as recited in claims 1 and 10. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. . . . [T]he term "plastic material" includes polymeric fabric or film material, which may or may not be liquid impervious. Hence, the claims are broader in scope than the disclosure of the invention.

Applicant has herein amended claims 1 and 10 to include the limitation of a "a liquid impervious plastic material." Thus, Applicant respectfully submits that there are no grounds for such a rejection in this application.

**REJECTION OF CLAIMS 9 and 17 UNDER 35 U.S.C. § 112 FIRST
PARAGRAPH**

In the previous Final Office Action, the Examiner rejected claims 9 and 17 under 35 U.S.C. § 112 for failing to reasonably provide enablement for "an adhesive material" as recited in claims 9 and 17. In particular, at page 3, paragraph 6 of the previous Final Office Action the Examiner stated the following:

Claims 9 and 17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "a layer of adhesive material... that facilitates the temporary attachment of bottom layer 14 to surface 11" (page 6, lines 16-18), does not reasonably provide enablement for "an adhesive material" as recited in claims 9 and 17. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. . . . [T]he term "an adhesive material" includes adhesives which are permanent, which is outside the scope of Applicant's disclosure.

Applicant has herein amended claims 9 and 17 to include the limitation of a "an adhesive material disposed thereon that facilitates a temporary attachment of said second layer to said surface." Thus, Applicant respectfully submits that there are no grounds for such a rejection in this application.

REJECTION OF CLAIMS 1-17 UNDER 35 U.S.C. § 103 (Garland/Reaves)

In the previous Final Office Action, the Examiner rejected claims 1-17 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,266,390 issued to Garland alone, or in view of U.S. patent 5,368,912 issued to Reaves. In particular, at page 4, paragraph 8 of the previous Final Office Action the Examiner stated that:

[I]t appears that the Examiner's position was not clearly conveyed in the last Office Action. Specifically, it is argued that Garland teaches the importance of the nonwoven to be absorbent. Applicant is hereby given Official Notice that cotton and rayon are known in the art for their *absorbent properties*. Hence, it would have been obvious to one skilled in the art to substitute a known absorbent fiber,

such as cotton or rayon, for the polypropylene of the Garland invention. Alternatively, Reaves teaches the equivalency of polypropylene and cotton *fibers* in a protective cover laminate (col. 2, lines 55-56). Therefore, it would have been obvious to one skilled in the art to substitute cotton fibers for the polypropylene fibers of the Garland invention. In either case, the motivation to substitute cotton or rayon for the polypropylene would be to improve the hand and the absorbency of the dropcloth of Garland. . . . (emphasis added)

Because neither Garland nor Reaves disclose a teaching, motivation, or suggestion to substitute *nonwoven* natural fibers for the polypropylene in the Garland invention, Applicant respectfully reiterates his right to have the Examiner produce documentary proof to support this rejection. Regarding Garland alone, the proffered motivation for substituting the cotton or rayon is their absorbent properties. However, there are a plethora of properties which one of ordinary skill in the art would consider in selecting a suitable nonwoven material for a dropcloth. Just to name a few: machine-direction and cross-machine direction tensile strength, elasticity, durability, weight, and moisture-vapor transmission rates (evaporative/drying qualities), are all considerable. While cotton or rayon might have equivalent or even superior absorbency as compared to the polypropylene disclosed in Garland (a proposition in itself for which the Examiner has heretofore offered no documentary proof), they are undoubtedly inferior to polypropylene in at least some other respects. Thus, the Examiner may not establish by Official Notice that Garland alone teaches, motivates, or suggests anything more than, at most, *experimentation* to determine whether cotton, rayon, or some other natural fiber *might* be suitably substituted for the polypropylene.

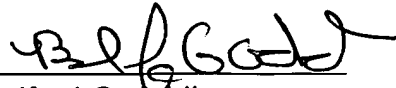
Reaves does not add anything to Garland relative to Applicant's claimed invention. Applicant's invention expressly includes a *nonwoven* natural fiber. Reaves merely mentions "woven fabrics such as cotton sheeting." For many of the same reasons discussed above, it is well known in the art that woven and nonwoven fabrics are not always suitable substitutes. As a result, Reaves does not provide the documentary proof of obviousness which is lacking in Garland.

Applicant respectfully submits that in the absence of actual documentary proof of obviousness, there are no grounds for such a rejection.

Conclusion

In view of the foregoing amendments and remarks, it is submitted that this application is in condition for allowance. Action to that end is hereby solicited.

Respectfully submitted,



Bradford G. Addison
Attorney for Applicant
Registration No. 41,486

April 5, 2000

Maginot, Addison & Moore
Bank One Center/Tower
111 Monument Circle, Suite 3000
Indianapolis, IN 46204-5130
Phone: (317) 638-2922
Fax: (317) 638-2139